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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,430	11/09/2000	Shuji Hanada	11151/5	5650

26646 7590 11/28/2001

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EXAMINER

WILKINS III, HARRY D

ART UNIT PAPER NUMBER

1742

DATE MAILED: 11/28/2001

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No.	Applicant(s)
	09/710,430	HANADA ET AL.
	Examiner	Art Unit
	Harry D Wilkins, III	1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 September 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Claims 1-16 are pending.
2. The objection to the specification and claims 11 and 12 have been withdrawn in view of the amendment filed 27 September 2001.
3. The rejection under 35 USC 112, 2nd paragraph has been withdrawn in view of the remarks and IDS filed 27 September 2001.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 9-11 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Araya et al (JP 10-219375 A).

These claims are rejected for the same reasons as stated in paragraph no. 6 of paper no. 6.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Farzon-Nia et al (US 5,429,504).

Claim 8 is rejected for the same reasons as stated in paragraph no. 8 of paper no. 6.

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Beyar et al (US 6,127,597).

Claim 12 is rejected for the same reasons as stated in paragraph no. 9 of paper no. 6.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Regan (US 4,795,458).

Claim 13 is rejected for the same reasons as stated in paragraph no. 10 of paper no. 6.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Kizelshteyn et al (US 5,215,105).

Claim 14 is rejected for the same reasons as stated in paragraph no. 11 of paper no. 6.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Araya et al (JP 10-219375 A) as applied to claim 1 above, and further in view of Besselink et al (US 5,551,871).

Claim 15 is rejected for the same reasons as stated in paragraph no. 12 of paper no. 6.

Response to Arguments

12. Applicant's arguments filed 27 September 2001 have been fully considered but they are not persuasive. Applicant has argued that the alloy of Araya et al does not have the shape-memory and superelastic properties as claimed.

In response, the Examiner points out that the claimed shape-memory and superelastic properties are not claimed in independent claim 1, only in dependent claims 5-7. Therefore, these arguments are addressed only to claims 5-7. The alloy of Araya et al is produced (see machine translation of paragraph [0009], [0010] and [0015]) by melting and casting as button ingots, followed by cold rolling. The alloy is then subjected to a solution heat treatment at 800-1000°C for 30-60 minutes. This process is substantially identical to the process disclosed in the specification as being used to make the alloy of the present invention. The only difference is that the present specification discloses a homogenization treatment at 1100°C for 12 hours before the cold rolling. One of ordinary skill in the art would have expected the alloy ingot of Araya et al to be homogenous because methods of casting create homogenous alloys.

Therefore, the Examiner asserts that there is no technical difference between the process of making disclosed by Araya et al and the process of making disclosed in the present application. Thus, one of ordinary skill in the art would have expected the alloy of Araya et al to inherently possess the shape-memory characteristics and superelasticity as claimed because the alloy of Araya et al has a composition which overlaps the presently claimed composition and is produced by a substantially identical method.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-F 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III
Examiner
Art Unit 1742

hdw
November 14, 2001

ROY KING *R*
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700